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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,241	05/30/2001	Philip D. Lapsley	8514-50	8211
60460 7590 12/28/2006 MARGER JOHNSON & MCCOLLOM/INDIVOS 210 SW MORRISON STREET SUITE 400 PORTLAND, OR 97204			EXAMINER MALHOTRA, SANJEEV	
			ART UNIT	PAPER NUMBER
			3693	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/871,241	LAPSLEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sanjeev Malhotra	3693	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05-30-2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06-17-2002 and 08-15-2002</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This is the first Office Action in response to the application, #09/871241, filed on May 30, 2001 and titled: "Biometric Financial Transaction System and Method".

### ***Abstract Objections***

The abstract of the disclosure is objected to because it exceeds one hundred and fifty (150) words in length. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Oath/Declaration***

A new oath or declaration is required because the applicant's referenced Oath/Declaration that is scanned as filed on October 3, 2001 is incomplete --- it is missing pages 3 and 4, and thus it does NOT have the signatures of the second and third inventors, respectively --- in the electronic files of USPTO. While the OIPE is making

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efforts to find the previously filed paper copy, it is suggested by the Examiner that the applicant would want to include a complete copy of the Oath/ Declaration in its reply to this Office Action, and reference it as such, so that it can be easily copied into the electronic files at USPTO and made a part of this application. Also, the Declaration filed on October 3, 2001 is missing the "Application Serial No." in the middle of its first page, and it should have been filled in by the applicant since the original application was filed on May 30, 2001 and it was assigned a serial number then.

Please note that the wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth in this communication. The substitute oath or declaration must be filed within the THREE-MONTH shortened statutory period set for reply in this Office Action. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136. Failure to timely file the substitute declaration (or oath) will result in an **ABANDONMENT** of this application. The transmittal letter accompanying the declaration (or oath) should indicate the date of the "Notice of Allowance" (PTOL-85) and the application number in the upper right hand corner.

### ***Drawing Objections***

The Drawings filed on May 30, 2001 in this application are objected to by the Examiner. The attached form PTO-948 describes the deficiencies with the Drawings filed in this application and it requires corrected drawings to be filed by the applicant.

In addition to "Replacement Sheet(s)" containing the corrected drawing figure(s), the applicant is required to submit a marked-up copy of each "Replacement Sheet" including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the **Abandonment** of the application.

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of the deficiencies noted above. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are

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required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

Claims 1-29 objected to because of the following informalities:

- Applicant does not have an opening phrase such as "I claim", "We claim", etc. by the applicant.
- Use of the term "identicator" has not been defined in these claims, nor is this word defined in any on-line dictionary that the Examiner used such as [www.dictionary.com](http://www.dictionary.com) or [www.thesaurus.com](http://www.thesaurus.com); also, the applicant is advised that there is a business firm called "Identicator Inc. --- An Armor Holdings Company" and unless this business firm is owned by the assignees of this application (#09/871241), there may be an infringement by this applicant in using the term "identicator" in its claims.
- Acronyms such as ESN in claim 9 are not defined in the claims, and the applicant is respectfully advised to include a list of all acronyms in the 'Specification'.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 of this application are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,870,723 issued on February 9, 1999 to Pare, et. al. and titled "Tokenless Biometric Transaction Authorization Method and System". Pare discloses the steps in a biometric authorization method for a commercial financial transaction in detail in its patent, please see especially column 4, lines 15 –58.

Claims 20-29 of this application are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,613,012 issued on March 18, 1997 to Hoffman, et. al. and titled "Tokenless Identification System for Authorization of Electronic Transactions and Electronic Transmissions". Hoffman discloses the system in detail in its patent, please see especially column 6, lines 41-58 and column 6, lines 64-67 and column 7, lines 1-8.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is:

- "Biometric Watermarks", US Patent #6,208,746 B1 issued to Musgrave, Clyde on March 27, 2001.
- "Biometric Authentication System", US Patent #6,219,439 B1 issued to Burger, Paul M. on April 17, 2001.

- "System and Method of Assessing the Quality of an Identification Transaction using an Identification Quality Score", US Patent #6,070,141 issued to Houvener, Robert C. and Hoenisch, Ian P. on May 30, 2000.
- "Digital Imaging System for Evidentiary Use", US Pub. No. 2001/ 0033661 A1 by Prokoski, Francine J. published on October 25, 2001.
- "Method, Apparatus and System for Verification of Human Medical Data", US Patent #5,876,926 issued to Beecham, James E. on March 2, 1999.
- "Tokenless Biometric Electronic Debit and Credit Transactions", US Patent #6,269,348 B1 issued to Pare, Jr. et. al. on July 31, 2001.
- "Tokenless Biometric Electronic Stored Value Transactions", US Patent #6,192,142 B1 issued to Pare, Jr. et. al. on February 20, 2001.
- "Tokenless Identification of Individuals", US Patent #5,805,719 issued to Pare, Jr. et. al. on September 8, 1998.
- "Tokenless Biometric Electronic Financial Transactions Via a Third Party Identifier", US Pub. No. 2001/0000535 A1 by Lapsley et. al. published on April 26, 2001.
- "Methods and Apparatus for Internet Based Financial Transactions with Evidence of Payment", US Patent #6,233,565 B1 issued to Lewis et. al. on May 15, 2001.
- "Remote Image Capture with Centralized Processing and Storage", US Patent #5,910,988 issued to Ballard, Claudio R. on June 8, 1999.



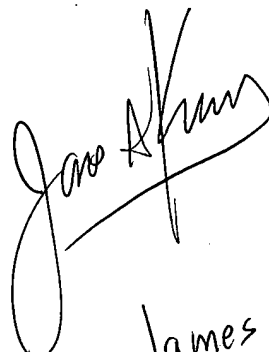
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SM

  
James Kramer  
12/21/06